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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,568	03/29/2001	Dillis V. Allen	G-38	4968

7590 05/15/2003

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT PAPER NUMBER

3711

DATE MAILED: 05/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.



### DETAILED ACTION

This Office action is responsive to communication received 02/24/2003 – paper styled, “RESPONSE TO OFFICE ACTION”.

Applicant's remarks with respect to the maintenance fees, the required supplemental reissue declaration and the pending litigation are acknowledged.

Claims 1-12 remain pending.

Following is an action on the MERITS:

Claims 8-12 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Specifically, as to claim 8, the applicant notes in his reissue declaration that claim 8 corresponds substantially to original patent claim 1 with the deletion of the phrase “having a top surface that is coplanar with or projects upwardly a short distance from the

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top wall" while also reciting that the ferrule is mounted "adjacent the hosel". Here, the applicant has failed to further recite that the ferrule has a downwardly depending flange seated "in a groove", as was the case in original claim 1 of the patent. The fact that the groove is an essential part of the claimed invention was vehemently argued on page 4 of the amendment received 11/23/1998 in parent application serial number 08/960,966.

Specifically, as to claim 9, the applicant notes in his reissue declaration that claim 9 corresponds substantially to original patent claim 6 with the cancellation of "on the hosel top surface" and the substitution therefor with the phrase "adjacent the hosel". Here, the applicant has failed to further recite that there exists an annular groove in the club head coaxial with the hosel bore and wherein the ferrule has an integral downwardly depending annular flange seated in the annular groove. Again, the fact that the groove is an essential part of the claimed invention was vehemently argued on page 4 of the amendment received 11/23/1998 in parent application serial number 08/960,966.

Specifically, as to claims 10, 11 and 12, the applicant notes in his reissue declaration that the phrase "substantially tangent" has been substituted for the term "tangent". Here, it is noted that the term "tangent" was specifically added by amendment to each of original claims 1, 6 and 7 and argued by the applicant in order to define over the prior art of record. See pages 1-3 of the amendment received 11/23/1998 in parent application serial number 08/960,966, wherein it is clear that the nature of the addition to the claims shows that this limitation (i.e., the addition of the term "tangent") was added in direct reply to the prior rejection.

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Claims 1-7 are allowable over the prior art references of record.


Claims 8-12 appear to avoid the prior art of record.

An initialed copy of the Information Disclosure Statement (IDS) received 05/13/2002 is enclosed with this Office action. The IDS has been slightly modified to facilitate the initialing, signing and dating of the IDS papers by the examiner. However, the content of the citations found on the IDS as filed by the applicant has not been altered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-308-7768 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
May 14, 2003